

REMARKS/ARGUMENT

Claim 35 has been amended to couch it as a process of use. Dependent claims 26, 27 and 28 have been similarly amended. The dependency of claims 32-34 have been corrected and new claim 36 added to present claims to the resulting product. Claims 29-31 have been canceled.

By presenting claims only to a process of use and a resulting process, applicants have complied with the original restriction requirement and election.

Claims 17, 19 and 24 were rejected in the original Office Action under the second paragraph of 35 USC 112, as being indefinite. The claims were rejected because they embraced non-elected subject matter. This rejection is respectfully traversed.

Claims 17, 19 and 24 have been cancelled.

Applicant contends that all of the presented claims are directed to the elected species. In the claims, the film-forming binder is starch, the anionic polymer is a hydrolyzed copolymer of styrene-maleic anhydride; and the cationic monomer is a polyamidoamine-epichlorohydrin resin. Dependent claim 26 further defines the hydrolyzed copolymer of styrene-maleic anhydride that forms a part of the composition used in the method as having a copolymer of styrene-acrylic ester dispersed therein. The recent Communication points to original claim 6 and its separate recitation of a species and a sub-species. The Communication concludes that the claim presented them as separate and distinct species. Applicants submit that the assertion in the Office Action is mere semantics. By listing the chemical genus and a chemical subgenus in the same claim, applicants were not making any concession about the separateness of the subject matter.

Basic claim interpretation law provides the reason that the subject matter of these separate claims should be considered as genus and subgenus and examined together. A method of sizing a cellulosic web with a composition containing a hydrolyzed copolymer of styrene-maleic anhydride along with starch and a polyamidoamine-epichlorohydrin resin is embraced by claim 35. Adding a copolymer of styrene-acrylic ester to the composition used in the method, whether that copolymer is dispersed in the anionic polymer or not, is still embraced by that same method.

Claims 13, 14, 18, 19 and 24 were rejected under 35 USC 102(b) as being anticipated by Burdick, US 6,359,040; while claims 17 and 25 were rejected under 35 USC 103(a) as being obvious over Burdick in view of Gray et al, US 3,297,657. These rejections are respectfully traversed.

All of the rejected claims have been canceled.

The new claims are neither anticipated, nor obvious over the Burdick '040 patent, whether viewed alone or in combination with the Gray '657 patent.

Burdick '040 describes an aqueous composition comprising a first ionic polymer, generally an anionic polymer and a viscosity promoter having a net ionic charge opposite to that of the ionic polymer, generally comprising a cationic polymer. The patent alludes to the use of the described composition for the surface sizing of paper (see col. 3, lines 60 et seq.). Anionic polymers are identified at col. 9, lines 42-67; while cationic polymers are identified at the top of column 10 (see also col. 10, line 51 to col. 11, line 2). While SMA resins appear as an anionic polymer viscosity promoter at col. 11, lines 3-6), there is no mention or remote suggestion of using hydrolyzed SMA (with or without a dispersed polymer phase), particularly in combination with a polyamidoamine-epichlorohydrin resin. As demonstrated by the results presented in Example 4 of the pending application, this combination of ingredients is particularly effective as a surface size, exhibiting a combination of both superior hydrophobicity (as measured by HST) and excellent surface integrity (as measured by Adams Wet Rub). Such a combination of properties is not suggested by the cited references.

On the basis of the forgoing, applicants request reconsideration of the pending claims.

Respectfully submitted,

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